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NEW YORK, NY 10036-8403

EXAMINER
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SHANKER, JULIE MEYERS

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JAMES MALACKOWSKI and JASON COHEN

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Appeal 2015-006161  
Application 12/727,939  
Technology Center 3600

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Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and  
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1–22. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

Claim 1 is illustrative:

1. A method of facilitating exchange of patent-product information, the method comprising:

identifying, by a processor, a first set of entry parameters for a first plurality of users, each user of the first plurality of users belonging to a first source type, and identifying, by the processor, a second set of entry parameters, different from the first set of entry parameters, for a second plurality of users, each user of the second plurality of users belonging to a second source type,

wherein the entry parameters establish at least one of the amount, type, and availability of the information that each user belonging to the user's respective source type is allowed to submit to a patent-product database;

receiving, by the processor, patent-product information from the first and second pluralities of users,

wherein the processor limits the receiving of the patent-product information from the first plurality of users according to the first set of entry parameters, and limits the receiving of the patent-product information from the second plurality of users according to the second set of entry parameters;

establishing, by the processor, a priority for a piece of patent-product information according to an input hierarchy created according to the source type associated with the user from whom the piece of patent-product information was received, the input hierarchy identifying the priority given to the patent-product information received from the user belonging to the first source type over the patent-product information received from a user belonging to the second source type different from the first source type;

storing, according to the established priority, the patent-product information in the patent-product database on a server in communication with the processor;

delivering, by the processor, at least some of the patent-product information to a public user; and automatically issuing

an alert to a previously-specified recipient at a previously-specified time before expiration of a patent associated with the patent-product information.

Appellants appeal the following rejection(s):

1. Claims 1–22 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.
2. Claims 1–22 under 35 U.S.C. § 103(a) as being unpatentable over Epstein (US 2002/0049738 A1, pub. Apr. 25, 2002), Ellis et al. (US 2008/0091684 A1, pub. Apr. 17, 2008 (*hereinafter* Ellis) and Coult (US 2002/0035571 A1, pub. Mar. 21, 2002).

### ISSUES

Did the Examiner err in rejecting claim 1 under 35 U.S.C. § 101 because (1) the claims have distinctive character including data input hierarchy and data filtering, (2) the method of the claims is not disclosed or suggested in the prior art, (3) and because the Examiner presents no evidence that the claims fail to recite an improvement to the functioning of a computer?

Did the Examiner err in rejecting claim 1 under 35 U.S.C. § 103(a) because the prior art does not disclose storing information according to the established priority which is established according to an input hierarchy created according to source type associated with the user from which the information is received?

## ANALYSIS

### Rejection under 35 U.S.C. § 101

The Examiner held that the claims are directed to the abstract idea of gathering and outputting data related to patented products. The Examiner held that the gathering and outputting product information are activities that are considered both fundamental economic or business practices and methods of organizing human activity. The Examiner found that the claims when taken in combination, together do not offer significantly more than the abstract idea itself because the claims do not recite an improvement to another technology or technical field, an improvement in the functioning of the computer itself or provide meaningful limitations beyond generally linking an abstract idea to a particular technological environment. Ans. 4. We agree that the claims are directed to an abstract idea.

We are not persuaded of error on the part of the Examiner by Appellants' argument that the claims have distinctive character including data input hierarchy and data filtering. The subject matter of the instant claims is similar to the subject matter in *Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343, 1346–47 (Fed. Cir. 2014) wherein the Federal Circuit held that patents that recited a method of (1) extracting data from hard copy documents using a scanner, (2) recognizing specific information from that data, and (3) storing that information in memory recited a well-known abstract idea. *Id.* at 1347. The *Content Extraction* court further noted that “humans have always performed” the functions of collecting, recognizing, and storing data, and that, notwithstanding the requirement that the functions be performed on a

scanner, the claims were “drawn to the basic concept of data recognition and storage.” *Id.* Here, the claims are directed to the basic concept of receiving, processing, and transmitting data which like collecting, recognizing, and storing data has long been performed by humans. In this regard, the distinctive characteristics the Appellants argue are recited in the claims relate only to collecting data, processing data and storing data.

We are not persuaded of error on the part of the Examiner by Appellants’ argument that the method of the claims as discussed in regard to the prior art rejection, constitutes a significant and technologically distinctive improvement. This argument of the Appellants’ arguments is directed to the novelty of the claimed invention. However, the analysis of patent eligibility is not an evaluation of novelty or non-obviousness, but rather, a search for ““an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.”” *Alice*, 134 S. Ct. at 2355. A novel and nonobvious claim directed to a purely abstract idea is, nonetheless, patent-ineligible. *See Mayo*, 132 S. Ct. at 1304.

We are not persuaded of error on the part of the Examiner by Appellants’ argument that the Examiner presents no evidence that the claims fail to recite an improvement to the functioning of a computer. We do not agree. The Examiner recited that the steps of the claims are performed by a generically recited processor performing generic computer functions that are well-understood, routine and conventional and previously known in the industry. This finding is supported by Appellants’ own specification which states at paragraph 29, “Useful machines for performing the operation of the methods include general purpose digital computers or similar devices.” In

addition, although the Appellants argue that that the method of the claims results in faster processing speeds, faster searching of storage records, and faster retrieval and delivery of requested information, we find nothing in the Specification, nor do Appellants point to anything in the Specification, to indicate that any increased speed, usability, or efficiency comes from the claimed invention itself, rather than from the capabilities of the recited “computing device,” i.e., the general-purpose computer (*see, e.g.*, Spec. ¶¶ 46, 51), responsible for performing the claimed method steps.

*See Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Can. (U.S.)*, 687 F.3d 1266, 1278 (Fed. Cir. 2012) (“[T]he fact that the required calculations could be performed more efficiently via a computer does not materially alter the patent eligibility of the claimed subject matter.”); *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015) (relying on a computer to perform routine tasks more quickly or more accurately is insufficient to render a claim patent-eligible).

In view of the foregoing, we will sustain the rejection as it is directed to claim 1. We will also sustain this rejection as it is directed to the remaining claims as the Appellants have not argued the separate eligibility of these claims.

Rejection under 35 U.S.C. § 103(a)

We will not sustain the Examiner’s rejection under 35 U.S.C. § 103(a) because we agree with the Appellants that the prior art does not disclose storing information according to the established priority which is established

according to an input hierarchy created according to source type associated with the user from which the information is received. In the Final Action the Examiner relies on paragraphs 39, 64–65, and 167 of Epstein.

We find that paragraphs 39 and 64 of Epstein describe what is called a metabase that is essentially a server that is accessed over a communication network. The metabase stores each unit of metadata as a subrecord of an original record in order to track each unit of data separately. Paragraph 65 discloses what the metadata includes. Paragraph 65 does mention source data but states that source data is first-hand information but does not state how this first-hand information is stored relative to second-hand information. Paragraph 167 discloses that the therein disclosed invention may be embodied in many different forms including as a computer program logic, microcontroller, digital signal processor and that the metabase logic is implemented as a set of computer program instructions. There is nothing in paragraph 167 related to how the metadata is stored much less a disclosure that the metadata is stored according to an established priority created according to source type.

In the Answer, the Examiner relies on additional paragraphs in Epstein such as paragraphs 66–72 and 110 and to paragraphs 64–72 of Ellis.

Paragraphs 66–72 disclose that the metadata in the metabase can be altered by users and that the reliability of the altered metadata can be evaluated by knowing the contributor of the metadata. Paragraph 110 discloses that a user can *retrieve* any version of the metabase information which could include or exclude information provided by certain contributors or retrieve just information related to a particular product or even retrieve previously deleted information. This paragraph, however, relates only to a



user's control over what information is retrieved and includes not how the information is stored.

Paragraphs 64–72 of Ellis discloses that a hierarchy may be created to give posters a status. However, this portion of Ellis does not disclose how the information is stored in the database.

As such, we will not sustain the Examiner's rejection of claim 1 and claims 2–8 dependent therefrom. We will also not sustain the Examiner's rejection of remaining claims because each of these claims includes similar subject matter.

#### DECISION

We affirm the Examiner's § 101 rejection.

We do not affirm the Examiner's § 103 rejection.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

#### ORDER

AFFIRMED